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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,547

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Chad D. Tillman

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

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EXAMINER

IWARE, OLUSEYE

ART UNIT

PAPER NUMBER

3687

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/816,547

**Applicant(s)**

TILLMAN, CHAD D.

**Examiner**

OLUSEYE IWARERE

**Art Unit**

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 57, drawn to a method of providing to a customer customized media at a physical point of sale of a good/service, classified in class 705, subclass 14.
  - II. Claims 58 – 62, drawn to a method of providing customized media to a customer at a physical point of sale of a good or service, classified in class 705, subclass 14.
  - III. Claim 63, drawn to a method, classified in class 705, subclass 14.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as determining a media content type that has been pre-selected by the customer. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination

is separately usable. In the instant case, subcombination III has separate utility such as maintaining in a computer database a plurality of media files for customers. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as determining a media content type that has been pre-selected by the customer. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement

will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. This application contains claims directed to the following patentably distinct species

Group A:

- Species A1, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a sleeve of a coffee cup that is provided to the customer.
- Species A2, wherein the step of communicating the generated deliverable comprises printing the item of the identified media 25 content type on a tray mat that is provided to the customer.

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- Species A3, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on packaging of a good that is sold to the customer.
- Species A4, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a bag in which a good is provided to the customer.

Group B:

- Species B1, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a sleeve of a coffee cup that is provided to the customer.
- Species B2, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a tray mat that is provided to the customer.
- Species B3, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on packaging of a good that is sold to the customer.
- Species B4, wherein the step of communicating the generated deliverable comprises printing the item of the identified media content type on a bag in which a good is provided to the customer.

- Species B5, wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to the customer.
- Species B6, wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a mobile computer device of the customer.
- Species B7, wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a personal digital assistant of the customer.
- Species B8, wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a personal communication device of the customer.
- Species B9, wherein the step of communicating the generated deliverable comprises wirelessly transmitting at the PPOS the item of the identified media content type to a web-enabled telephone of the customer.

Group C:

- Species C1, wherein the item of the identified media content type includes information obtained over the Internet at the time of the sale of the good or service.
- Species C2, wherein the item of the identified media content type comprises an electronic coupon.



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- Species C3, wherein the item of the identified media content type comprises a game piece of a promotion associated with the good or service sold.
- Species C4, wherein the item of the identified media content type comprises AvantGo type channel content.
- Species C5, wherein the item of the identified media content type includes a movie/video review.
- Species C6, wherein the item of the identified media content type includes a movie or video review of an upcoming or currently released movie or video.
- Species C7, wherein the item of the identified media content type comprises an electronic publication to which the customer subscribes.

Group D:

- Species D1, wherein the media content type comprises weather information.
- Species D2, wherein the media content type comprises nutritional information.
- Species D3, wherein the media content type comprises sports information.
- Species D4, wherein the media content type comprises news.
- Species D5, wherein the media content type comprises financial information.

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- Species D6, wherein the media content type comprises a stock quote.
- Species D7, wherein the media content type comprises traffic information.
- Species D8, wherein the media content type comprises a horoscope of the customer.

Group E:

- Species E1, wherein the deliverable comprises a cup sleeve having the item of the identified media content type printed thereon.
- Species E2, wherein the deliverable comprises a bag having the item of the identified media content type printed thereon.
- Species E3, wherein the deliverable includes a collection of web clippings.
- Species E4, wherein the deliverable includes a printout of a web page.
- Species E5, wherein the deliverable includes audio.
- Species E6, wherein the deliverable includes audio-video.
- Species E7, wherein the deliverable includes images and/or pictures.

Group F:

- Species F1, wherein the PPOS is a restaurant.
- Species F2, wherein the PPOS is a McDonald's restaurant.
- Species F3, wherein the PPOS is a Krispy Kreme restaurant.
- Species F4, wherein the PPOS is a coffee shop.
- Species F5, wherein the PPOS is a Starbucks coffee shop.

- Species F6, wherein the PPOS is a Seattle's Best coffee shop.
- Species F7, wherein the PPOS is a Caribou coffee shop.
- Species F8, wherein the PPOS is an automobile service store.
- Species F9, wherein the PPOS is a Firestone automobile service store.
- Species F10, wherein the PPOS is a video rental store.
- Species F11, wherein the PPOS is a Blockbuster video rental store.

4. This application contains claims directed to the following patentably distinct species Group A, comprising the species A1 - A4, Group B, comprising Species B1 - B9, Group C, comprising Species C1 - C7, Group D, comprising Species D1 - D8, Group E, comprising Species E1 - E7, and Group F, comprising Species F1 - F11. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In particular, in Group A, the species are independent or distinct because each represents a different step by which to print the item of the identified media content type. In Group B, the species are independent or distinct because each represents a different step by which to wirelessly transmit at the PPOS the item of the identified media content type. In Group C, the species are independent or distinct because each represents a different step by which the identified media content type includes. In Group D, the species are independent or distinct because each represents a different step by which the media content type comprises. In Group E, the species are independent or distinct because each represents a different step by which the deliverable comprises. In Group F, the species are independent or

distinct because each represents a different step by which the PPOS is recited. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 58 and 63 appear to be generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at

the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUSEYE IWARERE whose telephone number is (571)270-5112. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

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